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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,221	07/10/2003	F. Hayden Connor	01430USU/2402	2240

7590 02/15/2005

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EXAMINER
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KASENGE, CHARLES R

ART UNIT	PAPER NUMBER
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2125

DATE MAILED: 02/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/616,221	CONNOR, F. HAYDEN	
	Examiner	Art Unit	
	Charles R Kasenge	2125	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-17, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 11/22/04 have been fully considered but they are not persuasive. Although the Applicant disagrees, the Office reasserts that Mahachek discloses the cutting of the medium along the desired cut line (Figs. 3 and 4; col. 2, lines 59-64; col. 6 and 7, lines 59-67 and 1-15). The Office interprets "engraving" as a way of cutting a given medium and "geometrical programming" as determining the cut line from the desired image. Mahachek discloses engraving a mirror *and other products*. Mahachek also discloses producing desk set, picture frame, etc. which are commonly made out of wood. In light of these disclosures, the Office interprets Mahachek to implicitly disclose the use of wood as a medium. Mahachek also discloses a protruding portion that has an outline substantially similar to a contour of the picture, or desired image (col. 6 and 7, lines 59-67).

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-17, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Mahachek U.S. Patent 6,231,196. Referring to claims 1 and 12, Mahachek discloses a process for transferring a photo image to a medium comprising the steps of: converting a photo image into an electronic format (col. 6 and 7, lines 59-67 and 1-15); editing said photo image via a first

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electronic editor (col. 7, lines 25-42); converting said photo image via a second electronic editor into a format compatible with a computer aided laser system (col. 7, lines 43-53); importing said photo image into a third electronic editor to create a desired cut line; cutting the medium along the desired cut line via said computer aided laser system (Figs. 3 and 4; col. 2, lines 59-64; col. 6 and 7, lines 59-67 and 1-15); and etching said photo image to a medium via said computer aided laser system (col. 7, lines 54-57).

Referring to claims 2, 3, 13 and 14, Mahachek discloses the process of claim 1, wherein said medium is a wood and the process of claim 2, wherein said wood is in the form of a picture frame (col. 2, lines 38-52).

Referring to claims 4, 5, 15, 16 and 19, Mahachek discloses the process of claim 3, wherein said picture frame has a protruding portion on which the photo image is etched, said protruding portion being defined by said step of cutting the medium along the desired cut line. Mahachek discloses the process of claim 4, wherein said protruding portion overlaps at least a portion of the photograph display area associated with said picture frame (Fig. 18).

Referring to claims 6-9, Mahachek discloses the process of claim 1, wherein said photo image is converted into electronic format by scanning said photo image into a computer (col. 7, lines 1-15). Mahachek discloses the process of claim 1, wherein said first electronic editor enables a user to adjust the contrast, brightness and/or intensity of said photo image as appropriate to improve the quality thereof (col. 2, lines 53-67). Mahachek implicitly discloses the process of claim 1, wherein during said editing step said photo image is converted into an 8-bit grayscale (col. 7, lines 15-42). Mahachek discloses the process of claim 8, wherein said second

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electronic editor converts said grayscale to a format compatible with said computer aided laser system (col. 7, lines 43-57).

Referring to claims 10, 11, 17 and 20, Mahachek implicitly discloses the process of claim 1, wherein said third electronic editor enables a user to add text to said photo image (col. 2, lines 33-37). Mahachek discloses the process of claim 1, wherein said cut line coincides with features reflected in said photo image (col. 2, lines 15-26). Mahachek discloses the picture frame of claim 19, wherein said etched image is personalized to the preferences of a consumer (col. 2, lines 15-26).

### *Conclusion*

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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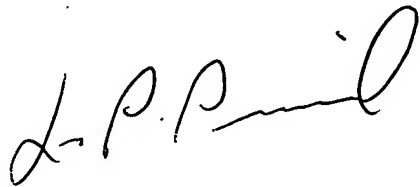
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles R Kasenge whose telephone number is 571 272-3743.

The examiner can normally be reached on Monday through Friday, 8:30 - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard can be reached on 571 272-3749. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CK  
February 9, 2005

A handwritten signature in black ink, appearing to read 'L. Picard', with a stylized flourish at the end.

**LEO PICARD**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2100**